

REMARKS

These amendments and remarks are being filed in response to the final Office Action dated November 17, 2005, pursuant to 37 C.F.R. § 1.116. For the following reasons this amendment should be entered, the application allowed, and the case passed to issue. This amendment should be entered because no new matter or considerations are introduced by this amendment. Claim 1 is amended to correct an informality in accordance with the Examiner's interpretation of the claims. No new considerations are raised, as the Examiner has expressly interpreted the claim to mean that the paper is selectively capable of absorbing oxidized sebum **from other types of sebum** (page 2 of Office Action). In addition, this amendment should be entered because it clearly places the application in condition for allowance or in better condition for appeal, as the amendment directly addresses the claim rejection under 35 U.S.C. § 112, second paragraph.

Claims 1-3 are pending in this application. Claims 1-3 are rejected. Claim 1 has been amended in this response.

Claim Rejections Under 35 U. S. C. § 112

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regards as their invention because the claims do not include the limitation "from other types of sebum." This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

Claim 1 has been amended to correct the informality noted by the Examiner.

Applicants submit that the claims fully comport with the requirements of 35 U.S.C. § 112.

Declaration Under 37 C.F.R. § 1.132

Although the Examiner withdrew the rejection of claims 1-3 under 35 U.S.C. § 102(f) based upon JP '820 and the rejection of claim 1 under 35 U.S.C. § 102(f) based upon JP '248, the Examiner required that a Rule 132 affidavit be filed that provides factual evidence that the named applicants of the present application are the inventors of the claimed invention. The Examiner bases this requirement on *In re Katz*, 215 USPQ 14, 18 (C.C.P.A. 1982). The Examiner's requirement of declaration under 37 C.F.R. § 1.132 is traversed, and reconsideration and withdrawal thereof respectfully requested.

Applicants respectfully submit that the Examiner has misinterpreted the holding in *In re Katz*. The Examiner has no basis for requiring a Rule 132 affidavit since there is no ambiguity regarding inventorship and the Examiner has withdrawn the rejections under 35 U.S.C. § 102(f).

Further, the Examiner already has a Declaration to that effect filed with the application. The Examiner has **no** basis upon which to **challenge the Declaration** filed with the application. As recognized by the Examiner, the relied upon disclosures in JP '820 and JP '248 are just that – disclosures not claims. The inventors of JP '820 and JP '248 do not lay claim to the portions of the disclosure previously relied upon by the Examiner. Since there are no pending rejections, the Declaration filed with the application must be accepted. Accordingly, the Examiner is requested to withdraw his requirement for an affidavit under 37 C.F.R. § 1.132.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-3 are rejected under 35 U.S.C. § 103 for obviousness based upon EP 0 393 723 (EP '723) in view of JP 11-137336 (JP '336), Fujii et al. (U.S. Pat. No. 5,041,252), JP 63188628 (JP '628) or JP 63027411 (JP '411). This rejection is traversed, and reconsideration and

withdrawal thereof respectfully requested. The following is a comparison between the present invention as claimed and the cited prior art.

An aspect of the invention, per claim 1, is a sebum absorbing paper used for applying to skin or for cleaning the skin comprising 1 to 30 % by weight inorganic filler. The inorganic filler comprises 50 to 100 % by weight hydroxyapatite. The paper has a basis weight of 5 to 25 g/m² and is selectively capable of absorbing oxidized sebum from other types of sebum.

The Examiner's primary reference, EP '723, is not directed to a paper used for applying to skin or for cleaning the skin, as recited in claim 1. Instead, as described in fields of application (a)-(g) on pages 9-10 of EP '723, the disclosed paper with hydroxyapatite is used for (a) deodorants, (b) filter mediums, (c) adsorbents, (d) substitute materials for biomaterials, (e) food wrapping papers, (f) articles in a bioindustry, and (g) articles in a medical treatment. Furthermore, as recited in claim 1, the claimed paper is capable of selectively absorbing oxidized sebum (e.g., lipids excreted from sebaceous glands in the skin) from other types of sebum; however, this feature is neither taught nor suggested by EP '723.

The Examiner's secondary reference of JP '336 was cited to teach a paper containing talc used to remove oil from the skin. However, JP '336 is completely silent with regard to the use of hydroxyapatite.

The Examiner's tertiary reference Fujii et al. is relied on as teaching that nonwoven fabric includes paper because the instant specification (page 4) discloses that the fiber used in the sebum absorbing paper includes cotton, acrylic fiber, rayon, and silk. Fujii et al., however, merely disclose implant materials having a good compatibility with a living organism. The reference to Fujii et al. is **remote** to sebum absorbing paper and does not suggest selectively absorbing oxidized sebum from other types of sebum, as required by claim 1.

Tertiary references, JP '628 or JP '411, were relied upon by the Examiner to teach that hydroxyapatite is used in a cosmetic product to absorb oxidized lipids. JP '411, entitled "Dust Preparation for Skin External Use," discloses a powdery preparation that is applied to the skin to "prevent or improve skin roughness." It is noted that JP '411 discloses a product that is not part of a paper, and JP '411 does not suggest that hydroxyapatite would be effective in selectively absorbing oxidized sebum from other types of sebum, as required by claim 1.

JP '628 is also not related to a paper product. Instead, JP '628, entitled "Drug for Skin External Use," is directed to a blend of a hydroxyapatite power with antiphlogistics and/or keratin release agents. As described in the abstract, the product can be in the form of a shape of cream, ointment, lotion, tonic, powder. JP '628, however, does not suggest that the hydroxyapatite can be used as a filler in a paper used to selectively absorb oxidized sebum from other types of sebum, as required by claim 1.

In summary, the applied references describe a non-skin related paper (i.e., EP '723), a paper to be used for cleaning the skin (JP '336), implant materials having a good compatibility with a living organism (Fujii et al.), and a pair of non-paper related products (i.e., JP '628 and JP '411).

With regard to the Examiner's prima facie obviousness assertion, it is submitted that the mere identification of various claim features in disparate references is insufficient to establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988). The Examiner's assertion "every element of the invention has been collectively taught" in itself is not dispositive, as it has been well recognized that "virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453

(Fed. Cir. 1998) (quoting *Environmental Designs, Ltd. v. Union Oil*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

The Examiner's stated motivation to combine the cited references is that "one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin." This statement merely describes an expected end result taught by the present disclosure without explaining why this result would have been expected (i.e., the rationale that would have led one skilled in the art to this result).

EP '723 is not directed to a paper used for applying to skin or for cleaning the skin. Despite the discussion of many different uses for the disclosed paper, including use as a filter medium and a food wrapping paper, EP '723 is completely silent about using the disclosed paper for applying to the skin or for cleaning the skin. Although EP '723 discloses that the "functional paper shows preferably a basis weight of 20g/m² or more," which falls within the claimed 5 to 25 g/m², the specific examples disclosed by EP '723 are all 48 g/m² or greater.¹ This weight of paper in the examples found in EP '723, although presumably appropriate for the heavier duty applications discussed in EP '723, would not have been recognized as appropriate for use on the skin for absorbing sebum, since sebum absorbing papers conventionally are thin and soft.

Based upon the absence of a teaching in EP '723 that the disclosed paper can be used for skin cleansing and the paper basis weights disclosed in the examples of EP '723, which are too heavy to be previously considered as sebum absorbing papers, one skilled in the art would not have recognized EP '723 as being directed to a paper used for applying to the skin or for cleaning the skin, as recited in claim 1. Thus, one skilled in the art of skin cleansing with paper would not look

¹ 85 g/m² in Example 4; 99 g/m² in Example 6; 93 g/m² in Example 9, 101 g/m² in Example 10; 103 g/m² in Example 11; 105 g/m² in Example 12, 98 g/m² in Example 13; and 48 g/m² in Example 14.

to a reference (i.e., EP '723) that teaches a product that is related neither to skin cleansing nor sebum removal.

References JP '628 and JP '411, cited to teach that hydroxyapatite absorbs oxidized lipids, are completely silent about using hydroxyapatite as a filler in a sebum absorbing paper. Instead, both these references disclose hydroxyapatite in the form of a powder that is directly applied to the skin or is applied via another delivery system, such with a cream, ointment, or lotion. These references, although disclosing many different systems in which the hydroxyapatite can be delivered to the skin, are conspicuously silent with regard to the use of hydroxyapatite as a filler for a sebum absorbing paper. The Examiner, however, has failed to explain why one having ordinary skill in the art would believe, with a reasonable expectation of success, that a product taught as being directly applied to the skin or used in other deliver systems *with the notable exception of paper*, could be applied to the skin with paper.

Notwithstanding that the Examiner has failed to supply a realistic motivation to combine the applied prior art to arrive at the claimed invention, it is submitted that even if the prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Claim 1 recites that the paper is selectively capable of absorbing oxidized sebum from other types of sebum. The problem this limitation is intended to solve (i.e., minimizing the absorption of other types of sebum, such as new sebum) has not been recognized by the prior art, and the applied prior art fails to explicitly teach selectively absorbing oxidized sebum.

Furthermore, even if one skilled in the art were to add hydroxyapatite to a sebum absorbing paper with knowledge of the teachings of the applied prior art, the record does not establish that such a paper would selectively absorb oxidized sebum from other types of sebum. The applied prior art discloses many different types of fillers for the paper (see, for example, page 9, lines 9-10

of EP '723) that can be combined with hydroxyapatite, and these fillers do not necessarily selectively absorb oxidized sebum from other types of sebum. There is no reason to conclude that the Examiner's proposed sebum absorbing paper, although including hydroxyapatite, would selectively absorb oxidized sebum from other types of sebum.

In order to establish the requisite realistic motivation, the Examiner must make clear and particular **factual findings** as to a **specific understanding or specific technological principle** and then, based upon such **facts**, explain **why** one having ordinary skill in the art would have been realistically motivated to modify a **specific prior art**, in this case presumably the papers and nonwoven fabrics of EP '723, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.* 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). This burden has **not** been discharged. As pointed out above, the Examiner has identified features in the applied references and then announced the obviousness conclusion without complying with judicial requirements requiring clear and particular factual findings and reasons based upon such findings. Instead what the Examiner has done is pointed to isolated features and then announced the obviousness conclusion. This approach is **legally erroneous**. *In re Dembiczak, supra*; *Grain Processing Corp. v. American-Maize Products Co.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

Applicants would stress that none of the applied prior art expresses any recognition for the problem of selectively absorbing oxidized sebum from other types of sebum. This failure of the applied prior art underscores the lack of motivation. As held by the Court of Appeals for the

Federal Circuit in *Ecolochem Inc. v. Southern California Edison, Co. supra*, at 56 USPQ2d

1076:

...There must still be evidence that “a skilled artisan,” confronted with the **same problems as the inventor** and with no knowledge of the claimed invention, would select the elements from the cited prior art references for a combination in the manner claimed.” (emphasis applied)

The Examiner does not gainsay that the applied references are mute as to selectively absorbing oxidized sebum from other types of sebum. Nevertheless, the Examiner assumes that the claimed invention would have been obvious because the Examiner has identified perceived features of the claimed invention in these disparate references. There is no automatic motivation, particularly in the present situation where the references are conspicuously silent as to the problem addressed and solved by the claimed invention.

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, there is a potent indicium of non-obviousness which the Examiner failed to consider.

It is well settled that the problem addressed and solved by the claimed invention must be given consideration in resolving the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). It should be apparent from the present specification that the problem addressed and solved by the claimed invention resides in formulating an absorbing paper which will selectively absorb oxidized sebum from other types of sebum. That problem is not recognized by the applied prior art. This being the case, the problem addressed

and solved by the claimed invention must be given consideration as a potent indicium of nonobviousness under 35 U.S.C. § 103.

The Examiner has failed to establish a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the problem of selectively absorbing oxidized sebum from other types of sebum which is addressed and solved by the claimed invention, and the failure of the applied prior art to appreciate that problem, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the **claimed subject matter as a whole**, obviousness within the meaning of 35 U.S.C. § 103. *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

Applicants, therefore, submit that the imposed rejection of claims 1 through 3 under 35 U.S.C. § 103 for obviousness predicated upon EP '723 in view of JP '336, Fujii et al., and JP '628 or JP '411 is not factually or legally viable and, hence, solicit withdrawal thereof.

In view of the above amendments and remarks, Applicants submit that this amendment should be entered, the application allowed, and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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